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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/571,991

03/15/2006

Laurent Francois Andre Hennequin

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11/27/2009

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
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EXAMINER

WILLIS, DOUGLAS M

ART UNIT

PAPER NUMBER

1624

MAIL DATE

DELIVERY MODE

11/27/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/571,991	Applicant(s) HENNEQUIN ET AL.	
	Examiner DOUGLAS M. WILLIS	Art Unit 1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 38-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 38-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>06-23-09</u> . | 6) <input type="checkbox"/> Other: _____ |

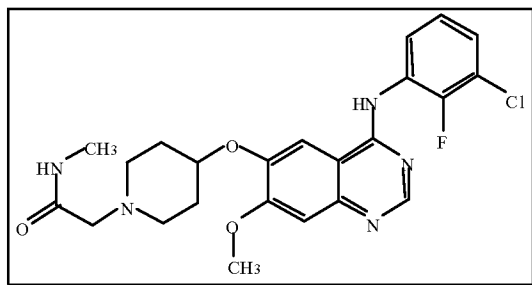
DETAILED ACTION

Status of the Claims / Priority

Claims 38-43 are pending in the current application. According to the *Amendments to the Claims*, filed April 6, 2009, claims 39, 40, 42 and 43 were amended and claims 1-37 and 44-71 were cancelled. This application is a 35 U.S.C. § 371 National Stage Filing of International Application No. PCT/GB2004/03937, filed September 15, 2004, which claims priority under 35 U.S.C. § 119(a-d) to: a) EP 03292309.6.7, filed September 19, 2003; and b) EP 04291248.5, filed May 14, 2004.

Status of Restrictions / Election of Species

Applicant's affirmation of the following election, without traverse, in the reply filed on



December 11, 2008, is acknowledged: a) Group I, claims 38-43; and b) substituted quinazolinamine - p. 58, example 1, shown left, and hereafter referred to as 4-(3-chloro-2-fluoroanilino)-7-methoxy-6-([1-(N-

methylcarbamoylmethyl)piperidin-4-yl]oxy}quinazoline.

The requirement was made FINAL in the *Final Rejection*, mailed on January 6, 2009.

The sections of U.S.C. Title 35 that formed the basis of prior rejections formulated, as well as any references supporting said rejections, that are not included with this Office action, may be found in either the *Non-Final Rejection*, mailed on August 19, 2008, the *Final Rejection*, mailed on January 6, 2009, or the *Non-Final Rejection*, mailed on May 26, 2009. Furthermore, any rejections or objections of record not explicitly addressed herein below, are hereby

Art Unit: 1624

withdrawn, in light of applicant's arguments, filed June 23, 2009.

Thus, a fourth Office action and prosecution on the merits of claims 38-43 is contained within.

Status of Claim Rejections - 35 U.S.C. § 103

Applicant's arguments, on pages 5-9 of the *Remarks*, filed June 23, 2009, with respect to claims 38-43, have been fully considered, but are not persuasive. Consequently, the rejection of claims 38-43, made in the *Non-Final Rejection*, mailed on May 26, 2009, is hereby maintained for the reasons of record.

Applicant primarily argues that the generalizations made by the Office fail to provide a reason to attempt to make the claimed composition or compound and hence are improper under MPEP § 2143.

In response to applicant's arguments that the generalizations made by the Office fail to provide a reason to attempt to make the claimed composition or compound and hence are improper under MPEP § 2143, the examiner respectfully disagrees.

MPEP § 2144-I states that *the rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law.* {See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); *In re Eli Lilly & Co.*, 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990); *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988); *Ex parte Clapp*, 227

Art Unit: 1624

USPQ 972 (Bd. Pat. App. & Inter. 1985); and *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993)}.

Moreover, MPEP § 2144.09 states that *a prima facie case of obviousness may be made when chemical compounds have very close structural similarities and similar utilities. An obviousness rejection based on similarity in chemical structure and function entails the motivation of one skilled in the art to make a claimed compound, in the expectation that compounds similar in structure will have similar properties.* {See *In re Payne*, 606 F.2d 303, 313, 203 USPQ 245, 254 (CCPA 1979); *In re Papesch*, 315 F.2d 381, 137 USPQ 43 (CCPA 1963); and *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1991)}.

Applicant should note that a *prima facie* case of obviousness based on structural similarity is rebuttable by proof that the claimed compounds possess unexpectedly advantageous or superior properties. {See *In re Papesch*, 315 F.2d 381, 137 USPQ 43 (CCPA 1963); *In re Wiechert*, 370 F.2d 927, 152 USPQ 247 (CCPA 1967); and *In re Peterson*, 65 USPQ2d 1379 (Fed. Cir. 2003)}.

Allowable Subject Matter

No claims are allowed.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

Art Unit: 1624

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DOUGLAS M. WILLIS, whose telephone number is 571-270-5757. The examiner can normally be reached on Monday thru Thursday from 8:00-6:00 EST. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. James O. Wilson, can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/DOUGLAS M WILLIS/
Examiner, Art Unit 1624

/James O. Wilson/
Supervisory Patent Examiner, AU 1624